

HAR 1 2 1997

Patent
Attorney Docket No. 18041.701

Case 2:04-cv-70366-JAC-RSW

Document 54-7 Filed 09/27/2005

Page 1 of 1

Applicant or Patentee: Gilbert Borman et al.

Serial or Patent No.: 08/727,085

Filed or Issued: October 3, 1996

For: Internet Search Tools

VERIFIED STATEMENT (DECLARATION) CLAIMING SMALL ENTITY
STATUS (37 CFR 1.90(f) and 1.27(e) - SMALL BUSINESS CONCERN

I hereby declare that I am:

the owner of the small business concern identified below;
 an official of the small business concern empowered to act on behalf of the concern identified below;

Name of Concern: Temerini Dynamics, Inc.

Address of Concern: 1 Oakland Towne Square, Suite 1690, Southfield, Michigan 48076

I hereby declare that the above identified small business concern qualifies as a small business concern as defined in 13 CFR 121.3-18, and reproduced in 37 CFR 1.9(d), for purposes of paying reduced fees under Section 41(a) and (b) of Title 35, United States Code, in that the number of employees of the concern, including those of its affiliates, does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third-party or parties controls or has the power to control both.

I hereby declare that rights under contract or law have been conveyed, to and remain with the small business concern identified above with regard to the invention, entitled

INTERNET SEARCH TOOLS

by inventors Gilbert Borman, Rajat Bhatnager, Arul Sebastian, Anup Mather, Vinay Wadhwa, Mukesh Kumar and C. Vinay Kumar Singh, described in

the specification filed herewith
 Application Serial No. 08/727,085, filed October 3, 1996
 Patent No. _____ issued _____

If the rights held by the above identified small-business concern are not exclusive, each individual, concern or organization having rights to the invention is listed below and no rights to the invention are held by any person, other than the inventor, who could not qualify as a small business concern under 37 CFR 1.9(d) or by any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).

Name: Gilbert Borman
 Address: 1 OAKLAND TOWNE SQUARE
SUITE 1690
SOUTHFIELD, MI 48076

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earlier of the issue fee or any maintenance fee due after the date on which status as a small business entity is no longer appropriate. (37 CFR 1.28(b)).

080727-580807

02/18/97 14:43 WILSON-SONSINI + 8103530383

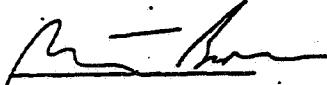
NO. 874 P003/003

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such wilful false statements may render the validity of the application, any patent issuing thereon, or any patent to which the verified statement is directed.

Name of Person Signing: Gilbert Norman

Title of Person Other Than Owner: President

Address of Person Signing: 1 Oakland Towne Square, Suite 1690, Southfield, Michigan 48075

Signature: 

Date: 2-28-97

08727095-100895

G 000172

Page 2 of
Case 2:04-cv-70366 Document 54 Filed 09/27/2005

D3C0

Attorney Docket No.: 18041-701



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Gilbert Sherman, et al.

Application No.: 08/727,825 683

Filed: October 8, 1996

Title: INTERNET SEARCH TOOLS

PATENT APPLICATION

Case 2004cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005

Page 3 of

Examiner: Not Yet Assigned

Group Art Unit: Not Yet Assigned

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8 - FIRST CLASS MAIL
I hereby certify that this correspondence is being deposited
postage prepaid, with the United States Postal Service as
"First Class Mail" in an envelope addressed to the Assistant
Commissioner for Patents, Washington, D.C. 20231 on
March 5, 1997.

Annette Granados (Signature)
Annette Granados

PETITION FOR EXTENSION OF TIME

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Pursuant to 37 C.F.R. § 1.136(a), an extension of time of:

| | Large Entity | Small Entity |
|------------|------------------------------------|--|
| Two Months | <input type="checkbox"/> \$ 390.00 | <input checked="" type="checkbox"/> \$195.00 |

and at least up to and including the filing date of the present paper is hereby requested to
respond to the Official Action mailed December 5, 1996.

PAYMENT OF FEES

The full fee due in connection with this Petition is \$195.00, and is provided as follows:

The fee is provided as set forth in the accompanying paper entitled
RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION.

Respectfully submitted,

Date: March 5, 1997

By: David J. Weitz

David J. Weitz
Registration No. 38,362 21-2415 03/31/97 06737215
34151 21A 127 .00M

WILSON SONSINI GOODRICH & ROSATI
650 Page Mill Road
Palo Alto, CA 94304-1505
(415)493-9300

PRIVATE INFORMATION TO NEXT TIME MST

G 000173



Case 2:04-cv-70366-JAC-RSW

Document 54-7 **PATENT**
Attorney Docket No. 38041-704 **Filed 09/27/2005**

Page 4 of 11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Gilbert Borman et al.

Application No. 08/727,825

Filed: October 8, 1996

For Internet Search Tools

Examiner: Unknown

Group Art Unit: Unknown

RECEIVED
AUG 15 97
GROUP 2600

CONSENT OF ASSIGNEE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Tenretni Dynamics, Inc., is the sole assignee of record for the above-referenced application. As the sole assignee, Tenretni Dynamics, Inc. hereby consents to the addition of C. Vinay Kumar Singh as a joint inventor of the above-referenced application.

Executed this 12th day of February 1997 at
Southfield Michigan, Michigan

Gilbert Bowman, President



CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage or first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on March 5, 1997.

Case 2:04-cv-70366-JAC-RSW

Annette Granados

Annette Granados

Document 12/12/12

Filed 09/27/2005

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PATENT

Attorney Docket No. 18041.701

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Gilbert Bowman et al.

Application No. 08/727,825

Filed: October 8, 1996

For: Internet Search Tools

RECEIVED

APR 9 1997

GROUP 2500

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MAY 15 1997
GROUP 2500

PETITION TO CHANGE INVENTORSHIP UNDER 37 C.F.R. 1.48(a)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This Petition is submitted under 37 CFR 1.48(a) to correct inventorship in the above-referenced application.

It is hereby requested that C. Vinay Kumar Singh be added as an additional inventor in this application.

This petition is accompanied by:

- (a) A declaration, including Verified Statement of Facts and Consent of Change of Inventorship Under 37 C.F.R. 1.48(a) by the original named inventors establishing when the error without deceptive intent was discovered and how it occurred;
- (b) A declaration of omitted inventor, C. Vinay Kumar Singh;
- (c) A copy of the combined declaration and power of attorney signed by each of the actual inventors as required under 37 C.F.R. 1.63. The original Declaration was filed with the U.S. Patent and Trademark Office in a response to the Notice to File Missing Parts dated December 6, 1996: 23132 122 130.00CH

PC Docs 123081

G 000175

- (d) Consent of Assignee; and
- (e) The commissioner is authorized to withdraw from Deposit Account No. 23-2415 (Docket No. 18041.701) the fee of \$65.00 to cover the cost of this petition as well as any additional fee or credit for overpayment as deemed appropriate. A duplicate of this paper is enclosed.

The above-identified application was filed on October 8, 1996, and C. Vinay Kumar Singh was inadvertently omitted as an inventor.

In October 1996 of this year, I was involved in the preparation and filing of the above-mentioned application. At the time this application was being prepared and filed, I did not realize that the claims as filed included contributions for which C. Vinay Kumar Singh should be named as a co-inventor. Less than a month after filing the patent application, the originally named inventors had occasion to carefully review the patent claims. At that time, it was brought to my attention that C. Vinay Kumar Singh should be named as a co-inventor. I then promptly prepared this petition to add Mr. Singh as a co-inventor.

The omission of C. Vinay Kumar Singh as a joint inventor of the above-referenced patent application was done with no deceptive intent.

For these reasons, favorable action on this petition is respectfully solicited.

Respectfully submitted,
WILSON SONSINI GOODRICH & ROSATI

By: David Weitz
David Weitz
Registration No. 38,362

650 Page Mill Road
Palo Alto, California 94304
(415) 493-9300

Date: March 5, 1997

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Inventors: Gilbert Borman et al.)
Application No. 08/727,825)
Filed: October 8, 1996)
For: Internet Search Tools)

VERIFIED STATEMENT OF FACTS AND CONSENT OF CHANGE OF
INVENTORSHIP BY GILBERT BORMAN ET AL. UNDER 37 C.F.R. 1.48(a)

1. We, Gilbert Borman, Rajat Bhatnagar, Arul Sebastian, Anup Mathur, Vinay Wadhwa and Mukesh Kumar are the originally named inventors of the above mentioned application filed on October 8, 1996, and assigned application number 08/727,085. Gilbert Borman is President of Tenretni Dynamics. Rajat Bhatnagar, Arul Sebastian, Anup Mathur are employees of HCL America where we hold positions as Engineers. Vinay Wadhwa and Mukesh Kumar are employees of HCL Consulting where we hold positions as Engineers.

2. Gilbert Borman contacted HCL America to discuss certain difficulties associated with conducting Internet searches. The originally named inventors, along with C. Vinay Kumar Singh, an engineer employed by HCL Consulting, worked on solutions to some of these difficulties which are described in the above mentioned application.

3. Around October 1996, Gilbert Borman, Rajat Bhatnagar and Charles C. Cary, patent counsel, were involved in preparing and filing the above-mentioned application. Due to the fact Mr. Singh was in India, he did not participate in the preparation of the application. At the time the application was filed, we did not realize that C. Vinay Kumar Singh had not been named as a co-inventor. Less than a month after filing the patent application, we had occasion to carefully review the patent claims and realized that C. Vinay Kumar Singh had not been named as a co-inventor.

Attorney Docket No. 18041.701
Page 2

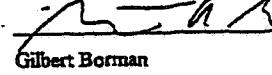
Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005

Page 8 of

4. The omission of C. Vinay Kumar Singh as a joint inventor of the above-referenced patent application was done with no deceptive intent. Once we learned that C. Vinay Kumar Singh had been omitted as an inventor we promptly contacted Charles C. Cary, patent counsel, to have Mr. Singh added as an inventor.

5. We make this verification with the full knowledge that willful false statements are punishable by fine or imprisonment or both (18 U.S.C. § 1001) and may jeopardize the validity of the patent above referenced. All statements made herein of my own knowledge are true. All statements made herein on information and belief, are believed to be true.

Executed this 7th day of January, 1997, at
Bloomfield Hills, Michigan.


Gilbert Borman

Executed this _____ day of _____, 1997, at

Connecticut.


Rajat Bhatnagar

Executed this _____ day of _____, 1997, at

Connecticut.


Arul Sebastian

Attorney Docket No. 18041.701
Page 3

Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005 Page 9 of

Executed this _____ day of _____, 1997, at
_____, California.

Amup Mathur

Executed this _____ day of _____, 1997, at
_____, India.

Vinay Wadhwa

Executed this _____ day of _____, 1997, at
_____, India.

Mukesh Kumar

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Inventors: Gilbert Borman et al.

Application No. 08/727,825

Filed: October 8, 1996

For: Internet Search Tools

RECEIVED
APR 15 1997
GROUP 2600

VERIFIED STATEMENT OF FACTS AND CONSENT OF CHANGE OF
INVENTORSHIP BY GILBERT BORMAN ET AL. UNDER 37 C.F.R. 1.48(a)

1. We, Gilbert Borman, Rajat Bhatnagar, Arul Sebastian, Amup Mathur, Vinay Wadhwa and Mukesh Kumar are the originally named inventors of the above mentioned application filed on October 8, 1996, and assigned application number 08/727,085. Gilbert Borman is President of Tenretni Dynamics. Rajat Bhatnagar, Arul Sebastian, Amup Mathur are employees of HCL America where we hold positions as Engineers. Vinay Wadhwa and Mukesh Kumar are employees of HCL Consulting where we hold positions as Engineers.

2. Gilbert Borman contacted HCL America to discuss certain difficulties associated with conducting Internet searches. The originally named inventors, along with C. Vinay Kumar Singh, an engineer employed by HCL Consulting, worked on solutions to some of these difficulties which are described in the above mentioned application.

3. Around October 1996, Gilbert Borman, Rajat Bhatnagar and Charles C. Cary, patent counsel, were involved in preparing and filing the above-mentioned application. Due to the fact Mr. Singh was in India, he did not participate in the preparation of the application. At the time the application was filed, we did not realize that C. Vinay Kumar Singh had not been named as a co-inventor. Less than a month after filing the patent application, we had occasion to carefully review the patent claims and realized that C. Vinay Kumar Singh had not been named as a co-inventor.

Attorney Docket No. 18041.701
Page 2

Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005

Page 11 of

4. The omission of C. Vinay Kumar Singh as a joint inventor of the above-referenced patent application was done with no deceptive intent. Once we learned that C. Vinay Kumar Singh had been omitted as an inventor we promptly contacted Charles C. Cary, patent counsel, to have Mr. Singh added as an inventor.

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Executed this _____ day of _____, 1997, at
_____, Michigan.

Gilbert Borman

Executed this _____ day of _____, 1997, at
_____, Connecticut.

Rajat Bhatnagar

Executed this _____ day of _____, 1997, at
_____, Connecticut.

Aru Sebastian

PC Docs 12366

G 000181

Attorney Docket No. 18041.701
Page 3

Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005 Page 12 of 12

Executed this _____ day of _____, 1997, at

California.

Anup Mathur

Executed this 30th day of January, 1997, at
New Delhi, India.

Vinay Wadhwa
Vinay Wadhwa

Executed this _____ day of _____, 1997, at

India.

Mukesh Kumar

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Inventors: Gilbert Borman et al.)
Application No. 08/727,825)
Filed: October 8, 1996)
For: Internet Search Tools)

VERIFIED STATEMENT OF FACTS AND CONSENT OF CHANGE OF
INVENTORSHIP BY GILBERT BORMAN ET AL. UNDER 37 C.F.R. 1.48(a)

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2. Gilbert Borman contacted HCL America to discuss certain difficulties associated with conducting Internet searches. The originally named inventors, along with C. Vinay Kumar Singh, an engineer employed by HCL Consulting, worked on solutions to some of these difficulties which are described in the above mentioned application.

3. Around October 1996, Gilbert Borman, Rajat Bhatnagar and Charles C. Cary, patent counsel, were involved in preparing and filing the above-mentioned application. Due to the fact Mr. Singh was in India, he did not participate in the preparation of the application. At the time the application was filed, we did not realize that C. Vinay Kumar Singh had not been named as a co-inventor. Less than a month after filing the patent application, we had occasion to carefully review the patent claims and realized that C. Vinay Kumar Singh had not been named as a co-inventor.

Attorney Docket No. 18041.701

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Page 14 of

4. The omission of C. Vinay Kumar Singh as a joint inventor of the above-referenced patent application was done with no deceptive intent. Once we learned that C. Vinay Kumar Singh had been omitted as an inventor we promptly contacted Charles C. Cary, patent counsel, to have Mr. Singh added as an inventor.

5. We make this verification with the full knowledge that willful false statements are punishable by fine or imprisonment or both (18 U.S.C. § 1001) and may jeopardize the validity of the patent above referenced. All statements made herein of my own knowledge are true. All statements made herein on information and belief, are believed to be true.

Executed this _____ day of _____, 1997, at
Michigan.

Gilbert Borman

Executed this 15 day of Jan 1997, at
Stratford, Connecticut.

Rajat Bhatnagar C-15 D-1 AFG 2 F 865 8/2/99
S/2/6

Executed this 20 day of Jan., 1997, at

Stamford. Connecticut.

Anil Sebastian

PC Doc# 123066

G 000184

Attorney Docket No. 18041.701
Page 3

Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005 Page 15 of

Executed this _____ day of _____, 1997, at
_____, California.

Anup Mathur

Executed this _____ day of _____, 1997, at
_____, India.

Vinay Wadhwa

Executed this _____ day of _____, 1997, at
_____, India.

Mukesh Kumar



Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005

PATENT
Application No. 10140700

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Inventors: Gilbert Borman et al.

Application No. 08/727,825

Filed: October 8, 1996

For: Internet Search Tools

VERIFIED STATEMENT OF FACTS AND CONSENT OF CHANGE OF
INVENTORSHIP BY GILBERT BORMAN ET AL. UNDER 37 C.F.R. 1.48(a)

1. We, Gilbert Borman, Rajat Bhatnagar, Arul Sebastian, Anup Mathur, Vinay Wadhwa and Mukesh Kumar are the originally named inventors of the above mentioned application filed on October 8, 1996, and assigned application number 08/727,085. Gilbert Borman is President of Tenretni Dynamics. Rajat Bhatnagar, Arul Sebastian, Anup Mathur are employees of HCL America where we hold positions as Engineers. Vinay Wadhwa and Mukesh Kumar are employees of HCL Consulting where we hold positions as Engineers, at the time invention was made.

2. ^{Pls. note} ^{01/31/97} Gilbert Borman contacted HCL America to discuss certain difficulties associated with conducting Internet searches. The originally named inventors, along with C. Vinay Kumar Singh, an engineer employed by HCL Consulting, worked on solutions to some of these difficulties which are described in the above mentioned application.

3. Around October 1996, Gilbert Borman, Rajat Bhatnagar and Charles C. Cary, patent counsel, were involved in preparing and filing the above-mentioned application. Due to the fact Mr. Singh was in India, he did not participate in the preparation of the application. At the time the application was filed, we did not realize that C. Vinay Kumar Singh had not been named as a co-inventor. Less than a month after filing the patent application, we had occasion to carefully review the patent claims and realized that C. Vinay Kumar Singh had not been named as a co-inventor.

Attorney Docket No. 18041.701
Page 2

Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005 Page 17 of 44
The omission of C. Vinay Kumar Singh as a joint inventor of the above-referenced patent application was done with no deceptive intent. Once we learned that C. Vinay Kumar Singh had been omitted as an inventor we promptly contacted Charles C. Cary, patent counsel, to have Mr. Singh added as an inventor.

5. We make this verification with the full knowledge that willful false statements are punishable by fine or imprisonment or both (18 U.S.C. § 1001) and may jeopardize the validity of the patent above referenced. All statements made herein of my own knowledge are true. All statements made herein on information and belief, are believed to be true.

Executed this _____ day of _____, 1997, at
Michigan.

Gilbert Borman

Executed this _____ day of _____, 1997, at
Connecticut.

Rajat Bhatnagar

Executed this _____ day of _____, 1997, at
Connecticut.

Arul Sebastian

Attorney Docket No. 18041.701
Page 3

Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005 Page 18 of

Executed this _____ day of _____ 1997, at

California.

Amup Mathur

Executed this _____ day of _____ 1997, at

India.

Vinay Wadhwa

Executed this 31 day of January, 1997, at
285. E. DEL MAR, APTS, India Pasadena, California - 91101
Mukesh Mukesh
1/31/97 Mukesh Kumar

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Inventors: Gilbert Borman et al.)
Application No. 08/727,825)
Filed: October 8, 1996)
For: Internet Search Tools)

VERIFIED STATEMENT OF FACTS AND CONSENT OF CHANGE OF
INVENTORSHIP BY GILBERT BORMAN ET AL. UNDER 37 C.F.R. 1.48(a)

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Attorney Docket No. 18041.701
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Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005

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Executed this _____ day of _____, 1997, at

Michigan.

Gilbert Borman

Executed this _____ day of _____, 1997, at

Connecticut.

Rajat Bhatnagar

Executed this _____ day of _____, 1997, at

Connecticut.

Arul Sebastian

Attorney Docket No. 18041.701
Page 3

Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005 Page 21 of 21

Executed this 6th day of February, 1997, at
Sunnyvale, California.

Anup Kumar Mathur
Anup Mathur

Executed this _____ day of _____, 1997, at
_____, India.

Vinay Wadiwa

Executed this _____ day of _____, 1997, at
_____, India.

Mukesh Kumar



Case 2:04-cv-70366-JAC-RSW

Document 54-7

Attorney Docket No. 18041.701

PATENT

Filed 09/27/2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Inventors: Gilbert Borman et.al.)
Application No. 08/727,825)
Filed: October 8, 1996)
For: Internet Search Tools)

DECLARATION OF: C. VINAY KUMAR SINGH

Assistant Commissioner for Patents
Washington, D.C. 20231
ATTN: BOX DAC

Sir:

I, C. Vinay Kumar Singh, declare that the following is true and correct:

1. I have worked at HCL Consulting since 5th June 1995 (Date) and presently hold the position of Project Leader (Title).

2. Upon my review of the claims presently pending in the above-referenced patent application, it is my belief that I am a co-inventor of subject matter claimed in at least one of the pending claims.

3. Gilbert Borman contacted HCL America to discuss certain difficulties associated with conducting Internet searches. I worked with the named inventors on solutions to these difficulties which are described in the above-mentioned application.

4. Around October 1996, the above-mentioned U.S. patent application was prepared and filed. I was aware that the above-referenced application was being prepared and filed, but did not participate in its preparation. Less than a month after filing the patent application, it was realized

USSN 08/727,825

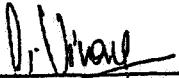
Page 2

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that I was not named as a co-inventor. Once this error was realized, I understand that patent
counsel was promptly requested to add me as a co-inventor.

5. I believe that the omission of my name as an inventor in the above-referenced patent
application was inadvertent and was not done with any deceptive intent.

6. I make this declaration with the knowledge that willful false statements and the like are
punishable by fine or imprisonment or both (18 U.S.C. § 1001) and may jeopardize the validity of
the patent. All statements of my own knowledge are true. I believe all statements made herein on
information and belief to be true.

Executed this 17th day of January 1997 at
New Delhi, India.


C. Vinay Kumar Singh

PATENT
Attorney Docket No. 18041.701

Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005
COMBINED DECLARATION AND POWER OF ATTORNEY
FOR UTILITY PATENT APPLICATION

As a below-named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name:

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

INTERNET SEARCH TOOLS

the specification of which

is attached hereto.

was filed on October 8, 1996 as Application Serial No. 08/727,085
and was amended on _____
(If Applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a) which states in relevant part: "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section....The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98."

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate as indicated below and have also identified below any foreign application for patent or inventor's certificate on this invention having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s) Priority Claimed

| (Number) | (Country) | (Day/Month/Year Filed) | Yes | No |
|----------|-----------|------------------------|-----|----|
|----------|-----------|------------------------|-----|----|

Attorney Docket No. 18041.701

Case 2:04-cv-70366-HAG-PSW Document 54-7 Filed 09/27/2005

Page 25 of

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulation, §1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

| (Application Serial No.) | (Filing Date) | (Patented, Pending, Abandoned) |
|--------------------------|---------------|--------------------------------|
|--------------------------|---------------|--------------------------------|

| | | |
|--------------------------|---------------|--------------------------------|
| (Application Serial No.) | (Filing Date) | (Patented, Pending, Abandoned) |
|--------------------------|---------------|--------------------------------|

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith, and to file, prosecute and to transact all business in connection with international applications directed to said invention:

| | |
|----------------------|--------|
| Stephen C. Durant | 31,506 |
| Mark A. Haynes | 30,846 |
| Paul Davis | 29,294 |
| Michael Hetherington | 32,357 |
| Mark C. Chan | 35,477 |
| Charles D. Holland | 35,196 |
| David J. Weitz | 38,362 |
| Michael J. Panepucci | 37,203 |
| Michael J. Murphy | 37,404 |
| Kent R. Richardson | 39,443 |
| Charles C. Cary | 36,764 |

Address all correspondence to:

Wilson, Sonsini, Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304

Direct all telephone calls to Charles C. Cary at (415) 493-9300.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Title 18, United States Code, §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

G 000195

Full name of second joint inventor, if any: Rajat Bhatnagar
Inventor's signature: _____
Date: _____
Citizenship: India
Residence: 1435 Bedford Street #5C, Stamford, CT 06905
Post Office Address: Same as above.

Full name of third joint inventor, if any: Arul Sebastian
Inventor's signature: _____
Date: _____
Citizenship: India
Residence: 60 Strawberry Hill Ave. #816, Stamford, CT 06902
Post Office Address: Same as above

Full name of fourth joint inventor, if any: Anna Mathur
Inventor's signature: _____
Date: _____
Citizenship: India
Residence: 370 E. El Camino Real #521, Sunnyvale, CA 94087
Post Office Address: _____
Same as above _____



PATENT
Attorney Docket No. 18041.701

COMBINED DECLARATION AND POWER OF ATTORNEY
FOR UTILITY PATENT APPLICATION
Case 2:04-cv-70566-JAC-RSW Document 54-7 Filed 09/27/2005

Page 28 of

As a below-named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

INTERNET SEARCH TOOLS

the specification of which

is attached hereto.

was filed on October 8, 1996, as Application Serial No. 08/727,085
and was amended on _____
(If Applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a) which states in relevant part: "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section....The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98."

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate as indicated below and have also identified below any foreign application for patent or inventor's certificate on this invention having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s)

Priority Claimed

| (Number) | (Country) | (Day/Month/Year Filed) | Yes | No |
|----------|-----------|------------------------|-----|----|
|----------|-----------|------------------------|-----|----|

G 000198

Attorney Docket No. 18041.701

Case 2:04-cv-70366-JAC-BSW Document 54-7 Filed 09/27/2005

Page 29 of 55

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulation, §1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

| (Application Serial No.) | (Filing Date) | (Patented, Pending, Abandoned) |
|--------------------------|---------------|--------------------------------|
|--------------------------|---------------|--------------------------------|

| | | |
|--------------------------|---------------|--------------------------------|
| (Application Serial No.) | (Filing Date) | (Patented, Pending, Abandoned) |
|--------------------------|---------------|--------------------------------|

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith, and to file, prosecute and to transact all business in connection with international applications directed to said invention:

| | |
|----------------------|--------|
| Stephen C. Durant | 31,506 |
| Mark A. Haynes | 30,846 |
| Paul Davis | 29,294 |
| Michael Hetherington | 32,357 |
| Hank C. Chan | 35,477 |
| Charles D. Holland | 35,196 |
| David J. Weitz | 38,362 |
| Michael J. Panepucci | 37,203 |
| Michael J. Murphy | 37,404 |
| Kent R. Richardson | 39,443 |
| Charles C. Cary | 36,764 |

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Title 18, United States Code, §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

26300T-590272/80

G 000199

Full name of second joint inventor, if any: Rajat Bhainagar

Inventor's signature: _____
Date: _____
Citizenship: India
Residence: 1435 Bedford Street #5C, Stamford CT 06902
Post Office Address: Same as above

Full name of third joint inventor, if any: Amil Sebastian
Inventor's signature: _____
Date: _____
Citizenship: India
Residence: 60 Strawberry Hill Ave. #816 Stamford CT 06902
Post Office Address: Same as above

Full name of fourth joint inventor, if any: Amp. Mathur
Inventor's signature: _____
Date: _____
Citizenship: India
Residence: 370 E. El Camino Real #521, Sunnyvale, CA 94087
Post Office Address: Same as above

Full name of sole or
first inventor:

Gilbert Borman

Inventor's signature:

Case 2:04-cv-70366-JAC-RSW

Document 54-7

Filed 09/27/2005

Page 31 of

Date:

Citizenship:

Residence:

Post Office Address:

U.S.A.

554 Remington, Bloomfield Hills, MI 48304

Same as above

2nd
Full name of second joint
inventor, if any:

Rajat Bhakunari

Inventor's signature:

RAJAT BHAKUNARI

Date:

Citizenship:

Residence:

Post Office Address:

1/15/97

India

1435 Bedford Street #5C, Stamford, CT 06905 CT

Same as above

3rd
Full name of third joint
inventor, if any:

Anil Sebastian

Inventor's signature:

ANIL SEBASTIAN

Date:

Citizenship:

Residence:

Post Office Address:

1/20/97

India

60 Strawberry Hill Ave. #316, Stamford, CT 06902 CT

Same as above

Full name of fourth joint
inventor, if any:

Anup Mathur

Inventor's signature:

ANUP MATHUR

Date:

Citizenship:

Residence:

Post Office Address:

India

870 E. El Camino Real #521, Sunnyvale, CA 94087

Same as above

08727085 300896

Full name of sole or
first inventor:

Gilbert Borman

Inventor's signature:

Date:

Citizenship:

U.S.A.

Residence:

554 Remington, Bloomfield Hills, MI 48304

Post Office Address:

Same as above

Full name of second joint
inventor, if any:

Rajat Bhatnagar

Inventor's signature:

Date:

Citizenship:

India

Residence:

1435 Bedford Street #5C, Stamford, CT 06905

Post Office Address:

Same as above

Full name of third joint
inventor, if any:

Arul Sebastian

Inventor's signature:

Date:

Citizenship:

India

Residence:

60 Strawberry Hill Ave. #816, Stamford, CT 06902

Post Office Address:

Same as above

Full name of fourth joint
inventor, if any:

Anup Mathur

Inventor's signature:

Anup Kumar Mathur

Date:

3/5/92

Citizenship:

India

Residence:

870 E. El Camino Real #521, Sunnyvale, CA 94087 CA

Post Office Address:

Same as above

968800T-1000-2727-0880-000000000000

500Full name of fifth joint
inventor, if any:

Case 2:04-cv-08386-TAC-RSW Document 54-7

Vinay Wadhwa

Vinay Wadhwa

Inventor's signature:

Date:

January 17th, 1997

Citizenship:

India

Residence:

C2150 Vasant Kunj, New Delhi, India 110070

Post Office Address:

Same as above

Full name of sixth joint
inventor, if any:

Mukesh Kumar

Mukesh Kumar

Inventor's signature:

Mukesh Kumar

Date:

India

Citizenship:

A4C - 117, Janakpuri, New Delhi India 110058

Residence:

Same as above

Post Office Address:

700

Full name of seventh joint

inventor, if any:

C. Vinay Kumar Singh

C. Vinay Kumar Singh

Inventor's signature:

Vinay

Vinay

Date:

January 17th, 1997

Citizenship:

India

Residence:

A-502, Rail Vihar, Sector 15 phase II, Gurugram, India

Post Office Address:

Same as above

08727085-1000896

Full name of fifth joint
inventor, if any:

Vijay Wadhwa

Case 2

Dinner

Citizenship:

Residence:

Post Office Address:

600

Full name of steam-jet
inventor, if any:

Investor's signature:

Date: 11/11/04

Conclusions.

Residence:

Post Office Address.

Full name of seventh joint

inventor, if any:

Inventor's signature:

Date:

Citizenship:

Residence:

Post Office Address:

• 995-22780

88/727,085



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NUMBER | FLING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|--------------------|------------|-----------------------|---------------------|
| 08/727,085 | 16/03/96 | BORMAN | G 18041.701 |

LM-11/0303

CHARLES C CARY
WILSON SONSINI GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO CA 94304-1058

EXAMINER

HONG, S

ART UNIT

PAPER NUMBER

2772

DATE ISSUED

03/03/98 4

Case 2:04-cv-70366-JAC-RSW

Document 54-7

Filed 09/27/2005

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 10-8-96

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 O.G. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) NONE is/are withdrawn from consideration.

Claim(s) is/are allowed.

Claim(s) 1-26 is/are rejected.

Claim(s) is/are objected to.

Claims are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on is/are objected to by the Examiner.

The proposed drawing correction, filed on is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number)

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s).

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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Art Unit: 2772

-2-

Part III DETAILED ACTION
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1. This action is responsive to communications: application, filed on 10/8/96.
2. Claims 1-25 are pending in the case. Claims 1, 7, 18, 23 and 25 are independent claims.

Drawings

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

The drawings submitted with this application were declared informal by the applicant. Accordingly they have not been reviewed by a draftsperson at this time. When formal drawings are submitted, the draftsperson will perform a review. Any inquiries concerning drawing review should be directed to the Drawing Review Branch at (703) 305-8404.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
5. Examiner requests that Applicant review the application carefully for informalities including typographical errors.

Claim Rejections - 35 USC § 112

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6. Claims 1-6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 claims both apparatus and method (in line 1, "A computer implemented method and system") as the subject matter. The hybrid structure renders the claim indefinite, since it is unclear what subject matter is actually being claimed. See Ex Parte Lyell, 17 USPQ2d 1548.

Claims that are noted above as being rejected but not specifically cited below are rejected based on their dependency on rejected independent claims.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 1, 7 and 18 are rejected under 35 U.S.C. 101 because the claims are directed to "Manipulation of Abstract Ideas Without a Claimed Practical Application" (the below paragraphs are from MPEP § 2106 Patentable Subject Matter - Computer - Related Inventions).

A process that consists solely of the manipulation of an abstract idea without any limitation to a practical application is nonstatutory. E.g., Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459. Office personnel have the burden to establish a *prima facie* case that the claimed invention taken as a whole is directed to the manipulation of abstract ideas without a practical application.

In order to determine whether the claim is limited to a practical application of an abstract idea, Office personnel must analyze the claim as a whole, in light of the specification, to understand what subject matter is being manipulated and how it is being manipulated. During this procedure, Office personnel must evaluate any statements of intended use or field of use, any data gathering step and any post - manipulation

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4

activity. See section IV.B.2(d) above for how to treat various types of claim language. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Further, when such a rejection is made, other personnel should determine how the language of the claims has been interpreted to support the rejection.

(b) **Statutory Process Claims**

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. To be statutory, a claimed computer - related process must either: (1) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan (discussed in (i) below), or (2) be limited by the language in the claim to a practical application within the technological arts (discussed in (ii) below). See *Diamond v. Diehr*, 450 U.S. at 183 - 84, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787 - 88 (1877)) ("A [statutory] process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject - matter to be transformed and reduced to a different state or thing The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence."); See also *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556 - 57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *id.* at 1569, 31 USPQ2d at 1578 - 79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical application") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114 - 19). The claimed practical application must be a further limitation upon the claimed subject matter if the process is confined to the internal operations of the computer. If a physical transformation occurs outside the computer, it is not necessary to claim the practical application. A disclosure that permits a skilled artisan to practice the claimed invention, i.e., to put it to a practical use, is sufficient. On the other hand, it is necessary to claim the practical application if there is no physical transformation or if the process merely manipulates concepts or converts one set of numbers into another.

Accordingly, the presently pending independent claims 1, 7 and 18 are non-statutory, since it neither: "(1) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan" or "(2) be limited by the language in the claim to a practical application within the technological arts".

The claims presently recite the steps of "receiving... information", "parsing said... information..." and then "selecting...site identifiers" which are all performed inside of a computer without any transformation outside the computer. Furthermore, none of those limitations constitutes a "practical application". As Examiner understands, the practical application in the Applicant's invention is using the "identifier" to retrieve data from the

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-5-

remote internet sites which are then displayed on screen. Thus, the independent claims must

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be limited by a language in the claims to such practical application within the technological

arts.

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Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 1-5, 7-11 and 13-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's admitted known prior art.

On page 3 of the specification, in the Background Information section, applicant admits that "Yahoo" search engine was a well known prior art.

As per independent claim 1, Applicant admits that the following claimed steps in a method for retrieving information from network was well known in the art:

- receiving a first file of information which includes site identifiers and other information (in FIG.4, at the bottom of the figure, the dialog box shows input area for the user to type in keywords for search, and item 406 in FIG.5 shows the window with the received results.);

- parsing said 1st file of information to extract a list comprising site identifiers (since the "NETSCAPE" browser in FIGs.4 and 5, parses the HTML document and underlines the URL hotlinks.);

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currently selected and automatically selecting an other of said site identifier form said file
(e.g., the Yahoo search engine shown in FIG.5C, item 588 "Next 20" shows where the user activates the next page request, and in view of the current page, the next page (i.e., site) identifier is automatically chosen.).

As per dependent claims 2 and 3, which are dependent on claims 1 and 2, respectively, the prior art further shows accessing and displaying a 2nd file (since the browser displays the second file containing the "Next 20" items.).

As per dependent claims 4 and 5, which are dependent on claims 1 and 3, respectively, the prior art further shows that the identifiers comprise URLs (as Applicant admits on page 3 of the specification, line 21, "A hot-link comprises ...a corresponding URL").

Independent claim 7 and its dependent claims 8-11 are for computer readable medium comprising the methods of claims 1-5, respectively, and are similarly rejected under the same rationale.

Independent claim 13 and its dependent claims 14-17 recite substantially similar limitations as claims 1-5, respectively, and are similarly rejected under the same rationale. Furthermore, Applicant's admitted prior art discloses the additional feature of "automatically sending a plurality of jump commands to the browser", since the Yahoo search engine (in FIG.5C, item 406) shows a plurality of URL links and the user activation of those links are automatically translated to the browser as the request to retrieve files from the URLs.

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-7-

Independent claim 18 and its dependent claims 19-22 are for computer readable medium comprising the methods of claims 6-11, respectively, and are similarly rejected under the same rationale.

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Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention date of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of AltaVista, "<http://www.altavista.com>", 2/20/98, screen printouts pp.1-2. Note that although the printouts of the AltaVista search engine was made on 2/20/98, as Applicant admits on page 4, line 7 of the specification, it was available to public before the filing date of the present application.

As per dependent claim 6, which is dependent on claim 5, Applicant's admitted prior art discloses the limitations of claim 5, but does not explicitly teach the following additional limitations: automatically selecting from a group consisting of: a next site identifier, a prior site identifier, a first site identifier and a last site identifier. In the Applicant's admitted prior art of the Yahoo search engine, this feature does not seem to be shown. However, another

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well known search engine called AltaVista discloses this feature (see page 2 of the print out, Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005 as the "Prev" icon, "Next" icon, "1" icon and "20" icon). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have incorporated the feature of AltaVista into Yahoo, since they both taught accessing the site identifiers resulted from a search, and AltaVista taught the features which improved user interface for the navigation.

Dependent claims 12 is for computer readable medium comprising the methods of claim 6, and is similarly rejected under the same rationale.

13. Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of CNN Interactive, "<http://cnn.com/index>", 2/20/98, screen printout pp.1-7. It is noted that although the screen printout date of the CNN web site is 2/20/98, Examiner takes an Official Notice that the CNN Interactive web site was available to the public before the filing date of the present application.

As per independent claim 23, the CNN Interactive teaches the following claimed limitations:

- receiving into a browser window a 1st file of information network (on page 1 of the printout, as the content of the CNN page is received.);
- displaying a jumper window (on page 1, on the left most column, the jumper window containing the index image of "WORLD", "U.S.", "LOCAL" ...);
- selecting and receiving one of said 1st site identifier from said browser (on page 5, see the jumper window as the "EARTH" was chosen and the right window shows that the "EARTH MAIN PAGE" is retrieved.);

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- selecting and receiving an other of said 1st file identifier from said jumper window
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(on page 5 of the printout, since each of the "WORLD", "U.S", "LOCAL", indexes is
accessible.).

However, the claimed invention differs from the prior art of CNN Interactive in that the prior art fails to show the steps of: parsing the 1st file of the information to extract a list comprised of said 1st file site identifiers and then receiving into said jumper window said set of 1st file site identifiers. Regarding this feature, the Applicant's admitted prior art at least shows the feature of parsing the 1st file retrieved, as FIG.5B shows that the URL links are underlined by the browser after the browser parsed the 1st file and recognized the existence of the URLs. Therefore, the issue is whether or not it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided, to the Yahoo, the jumper window like that of CNN Interactive. In view of the prior art teachings as a whole, such feature would have been obvious to a person of ordinary skill in the art at the time the invention was made, since the CNN-like jumper window in the Yahoo search engine would have given the user the concurrent access to the URL indexes while viewing the contents of an index.

Dependent claim 24, which is dependent on claim 23, recites substantially similar limitations as claim 5, and is similarly rejected under the same rationale.

Independent claim 25 and its dependent claim 26 are for computer readable medium comprising the methods of claims 23 and 24, respectively, and are similarly rejected under the same rationale.

Serial Number: 08/727,085
Art Unit: 2772

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 305-9701.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

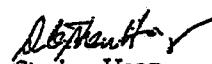
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or faxed to:
(703) 308-9051, (for formal communications intended for entry)

Or:
(703) 305-9724 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Effective November 16, 1997, the Examiner handling this application will be assigned to a new Art Unit as a result of the consolidation into Technology Center 2700. See the forth coming Official Gazette notice dated November 11, 1997. For any written or facsimile communication submitted ON OR AFTER November 16, 1997, this Examiner, who was assigned to Art Unit 2412, will be assigned to Art Unit 2772. Please include the new Art Unit in the caption or heading of any communication submitted after the November 16, 1997 date. Your cooperation in this matter will assist in the timely processing of the submission and is appreciated by the Office.


Stephen Hong

Patent Examiner

February 20, 1998

G 000214

FORM PTO-892

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICESERIAL NO.
08/727,085GROUP ART UNIT
2733..ATTACHMENT
TO PAPER NO.
4

NOTICE OF REFERENCES CITED

APPLICANT(S)

Berman et al.

U.S. PATENT DOCUMENTS

Case 2:04-cv-70366-JAC-RSW Document 54-7 Filed 09/27/2005

Page 45 of

| | DOCUMENT NO. | DATE | NAME | CLASS | SUB-CLASS | PERIOD DATE IF APPROPRIATE |
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OTHER REFERENCES (including Author, Title, Date, Pertinent Pages, etc.)

| | |
|---|---|
| R | CNN Interactive, "http://chn.com/index", 2/20/98, screen printout pp.1-7. |
| S | AltaVista, "http://www.altavista.com", 2/20/98, screen printouts pp.1-2. |
| T | ★ |

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|--------------------------|-----------------|--|
| EXAMINER Stephen Hong | DATE 2/20/98 | |
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See Manual of Patent Examining Procedure, section 707.05(a).

G 000215

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY-DOCKET NO. |
| 08/27/05 | 107487/96 | BURMAN | 15041-701 |

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LM41/0608

EXAMINER

HUNG, S

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DRAFT

DRAFT

PATENT

Attorney Docket No. 18041.701

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Gilbert Bowman et al.)
Application No. 08/727,085) Group Art Unit: 2772
Filed: October 8, 1996) Examiner: Stephen Hong
Title: INTERNET SEARCH TOOLS)

AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Responsive to the Official Action of March 3, 1998, Applicant respectfully requests reconsideration of the above-identified application in view of the following amendments and remarks.

IN THE SPECIFICATION:

IN THE TITLE:

Please delete the title "Internet Search Tools" and amend to read - METHOD AND APPARATUS FOR RETRIEVING DATA FROM A NETWORK USING LOCATION IDENTIFIERS-

-1-

2004APCDOCS12165128

IN THE CLAIMS:

Please cancel claims 2-3, 8-9, 14-15 and 19-20.

~~Please amend the remaining claims 1, 4-7, 10-13, 16-18 and 21-26 as follows:~~

1. (Amended) A computer implemented method [and system for retrieving information from] for searching on a local computer a network of nodes with data files stored at corresponding ones of the nodes and each of the data files identifiable by a location identifier and several of the data files containing location identifiers for others of the data files, and the method for searching comprising the [following steps] acts performed on the local computer of [];

constructing a search window on a display screen of the local computer, displaying a first and a second icon on said display screen;

[receiving a 1st file of information] retrieving an initial data file from the network

together with displaying the initial data file in the search window, and the initial data file which includes site including location identifiers [and other information];

...aving [said 1st file of information] the location [to extract a list comprising

identifiers from the initial data file to form an initial list of location identifiers together with
those in the initial list corresponding to a selection of the first icon; and]

displaying any of the data files stored on the network in the search window and

currently selected and automatically selecting an other of said site identifiers from said list.]

the stored initial list together with displaying the first data file in the search window.

responsive to a selection of the second icon

1 4. (Amended) The computer implemented method of claim 1 wherein:
2 said [1st] initial data file comprises information in a markup language; and
3 said [site] location identifiers comprise URLs.

5. (Amended) The computer implemented method of claim [3] 1 wherein: